

**Notice of Allowability**

Application No.

09/980,542

Examiner

David T. Fox

Applicant(s)

KUCHUK ET AL.

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers filed 20 October 2006.
2. ☒ The allowed claim(s) is/are 1 and 3-24 renumbered as 1-23.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date 5/5/06 & 12/14/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Shawn P. Foley on 04 January 2007.

IN THE SPECIFICATION:

The first paragraph on page 1 of the specification, as added directly under the title by the preliminary amendment of 04 March 2002, was deleted and replaced with the following paragraph, to be inserted on page 1 of the specification, directly below the title:

---CROSS REFERENCE TO RELATED APPLICATIONS

The present application is a 371 of International Application PCT/US00/13555, filed 17 May 2000, which claims benefit of the filing date of United States Provisional Patent Application 60/134,459, filed 17 May 1999. The disclosures of all of said applications are incorporated by reference herein.---

On page 17, line 21, "was" was replaced with ---were---.

On page 17, line 22, "II" was replaced with ---I---.

IN THE CLAIMS:

Non-elected claims 25-32 and 36 were cancelled without prejudice.

Claim 3 was amended as follows:

---Claim 3 (currently amended). The method of claim 1, wherein said heterologous nucleic acid further comprises a recombination site and wherein said first plant, said second plant or both said first and second plants produce a recombinase specific to said recombination site.---

IN THE ABSTRACT:

The following Abstract was inserted as a separate page, after page 21:

---ABSTRACT

Disclosed is a method of making transgenic plants. Heterologous DNA is first introduced into a donor plant, plant cell or protoplast, and then moved from the donor to a recipient plant, plant cell or protoplast unaccompanied by any native genomic DNA of the donor. The donor and recipient are chosen that produce unstable progeny or demonstrate preferential segregation or sorting out. The DNA may be inserted randomly or at specific locations in the genome of the recipient plant. Also disclosed are transgenic plants produced by the methods, and plant progeny, plant parts and seeds and seed parts from the plants.---

The following is an examiner's statement of reasons for allowance:

The claims are allowed in view of the demonstration in the specification that a transposon/transposase system was able to introduce genetic material from a donor plant into a recipient plant, wherein the crossing of said plants produces unstable progeny or demonstrates preferential segregation or sorting out. See Example 1, pages 15-17 of the specification. In addition, it is now considered that given the availability of numerous transposon/transposase systems which function in plants transformed

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therewith, as stated on page 10 of the specification, top paragraph; and given the similar behavior of wide crosses between unrelated monocotyledonous species of the cereal family, as demonstrated by Gernand et al (2005), submitted by Applicant on 05 May 2006; the claims are enabled and adequately described as written; e.g., basis for amended claim 3 may be found on page 10 of the specification, lines 20-24; and Example IV, page 17, line 29 through page 18, line 2.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is 571-272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 04, 2007

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 480-1638

